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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,662	01/09/2002	Fletcher L. Chapin	END920010017US1	8236

23550 7590 05/13/2003

HOFFMAN WARNICK & D'ALESSANDRO, LLC  
3 E-COMM SQUARE  
ALBANY, NY 12207

EXAMINER

PRONE, JASON D

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

GL

<b>Office Action Summary</b>	<b>Application No.</b> 10/043,662	<b>Applicant(s)</b> CHAPIN ET AL.	
	<b>Examiner</b> Jason Prone	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I in Paper No. 4 is acknowledged.  
Claims 11-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **with** traverse in Paper No. 6.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the interior sloped side that is planar, from claim 5, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Addis.  
Addis discloses the same invention including a duct (16) including an interior sloped side (30) creating a first opening for receiving the part (Fig. 5) and a second

opening, that the part (B) exits the second opening in a substantially vertical orientation (Fig. 4), a machine for detaching the part from the web (14, 15), that the duct is coupled to the machine (Fig. 4) so that the part is received by the first opening of the duct after being detached from the web (Fig. 4), that the machine includes a punch (15) and a die (14), that the die includes an opening through which the part passes before it is received in the duct (13'), and that the interior sloped side is made of metal (It is inherent that the interior sloped side of the Addis patent is made of metal since it is known that most duct are made of metal).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Addis in view of Kiyoshi (JP5138595). Addis discloses the invention but fails to disclose that the interior sloped side is planar and that the second opening is smaller than the first opening. JP5138595 teaches an interior sloped side that is planar (20) and that the second opening is smaller than the first opening (Fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Addis with an interior sloped side that is planar and that the second opening is smaller than the first opening, as taught by JP5138595, to allow for the part to fall through the duct at a different orientation for stacking.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Addis in view of Hanas. Addis discloses the invention but fails to disclose that the duct includes a plurality of interior sloped sides. Hanas teaches a duct with a plurality of interior sloped sides (104). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Addis with a duct with a plurality of interior sloped sides, as taught by Hanas, to allow for the part to fall through the duct at a different orientation for stacking.

8. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Addis in view of Amarakoon further in view of Nakayama. Addis discloses the invention but fails to disclose a container, for holding the part, including an open end and a contoured end, that the open end is coupled to the duct to receive the part from the second opening, wherein the contoured end conforms to the curled shape of the part, that the container accommodates a plurality of curled shaped part stacked upon each other, and that the container is coupled to the duct using a u-shaped channel.

Amarakoon teaches a container, for holding the part, including an open end (67), that the open end is coupled to the duct to receive the part from the second opening (66), and that the container is coupled to the duct using a u-shaped channel (Fig. 1).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Addis with a container, as taught by Amarakoon, to allow all parts, to be cut, to be stacked and stored together.

Nakayama teaches a container with a contoured end (26), that the contoured end conforms to the curled shape of the part (Fig. 7), and that the container accommodates

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a plurality of curled shaped part stacked upon each other (Fig. 7). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Addis and Amarakoon with a container with a contoured end, as taught by Nakayama, giving the curled parts a snug fit, when stacked, and reducing chance of the part getting damaged.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Russell, Westermann, Hartzell ('426), Kramski, Hartzell ('553), Carmichael, Bakermans et al., Roberts, and Bender.

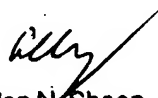
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is 703-605-4287. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen N. Shoap can be reached on 703-308-1082. In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



JP  
May 6, 2003



Allan N. Shoap  
Supervisory Patent Examiner  
Group 3700